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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,551	03/22/2007	Michael W. Leonard	S9025.1179	1621

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NEW YORK, NY 10036-2714

EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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03/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,551	Applicant(s) LEONARD ET AL.	
	Examiner Sanza L. McClendon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 06, 2008 has been entered.

Response to Amendment

2. In response to the Amendment received on March 06, 2009, the examiner has carefully considered the amendments. Please note that the record has changed and the new examiner is Sanza L. McClendon.

Response to Arguments

3. Applicant's arguments filed March 06, 2008 have been fully considered but they are not persuasive. Applicant appears to be relying on the amendment to overcome the rejection. However, the limitation "security document" does not overcome the rejection. This limitation does not change the basic and novel characteristics of the ink composition (not fluorescing under UV light). Said limitation (security note) in this case is merely a future intended limitation. Applicants admit on the record that Schmidt et al teaches intaglio inks but not security type intaglio inks, wherein applicant has not provided the office with or how the inks differ (intaglio ink vs. security intaglio inks). Schmidt et al meets all the requirements of the instant claim. The examiner notes the Declaration of record states that the photoinitiator of example 4 of the references comprises Darocure 4265 which is mixture of an acylphosphine oxide and an alpha-hydroxy ketone in a 50:50 ratio and that the hydroxy ketone in the mixture does fluoresce in the visible region when exposed to ultraviolet light. This is not

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convincing because the Declaration is silent with regard to the mixture fluorescing under the same described conditions. Acylphosphine oxide photoinitiators are known photobleaching initiators (see evidence from Decker et al, Polymer 42 (2001) 7551-7560). Wherein, as the examiner understands, photobleaching to be a decrease in the absorbance of a fluorophore with illumination time when exposed to light within a certain wavelength. Acylphosphine oxides are taught to photobleach in the 365 nm region—see evidence by Scranton. This appears to be the region (low energy UV light) that applicant exposed the Darocure 1173 and found that the initiator (1173) fluoresced. Therefore without evidence to the contrary and with the reasoning above it is deemed that the combination of photoinitiators in example 4 of the reference does not fluoresce when exposed to UV light because the photobleaching properties of the acylphosphine oxide in the photoinitiator combination will overcome the fluorescing properties of the other initiator in the combination (acylphosphine oxide photobleaches in the same region as the hydroxy ketone fluoresces). Regarding the arguments for picking and choosing as found on page 18 in reference to Schmidt et al, it is deemed that example 4 explicitly discloses a composition that anticipates the instant claims 1-8 for the reasons set forth above. Regarding the argument that the Declaration was dismissed because the argument was an obviousness argument and that the rejection is an anticipation rejection and therefore invalid, this is not convincing since anticipation is the epitome of obviousness—see *In re Skoner*, 186 USPQ 80; *In re Kalm*, 154 USPQ 10, 12; and *In re Pearlson*, 181 USPQ 641. Therefore the reasoning is not invalid since if fluoresced in not wanted in a composition then it would be within the skilled artisans' knowledge base to remove any fluorescing material and/or not add any fluorescing materials. The courts have upheld that it is obvious that omission of an element and its function in a combination where the remaining elements perform the same function as before the removal involves only routine skill in the art—*In re Karlson*, 136 USPQ 184. Therefore the rejections still stand in the absence of evidence to the contrary and/or unexpected results.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-8 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt (WO 2003/035777), see English language equivalent (Schmidt US 2005/0142292).

6. The text not found in this action can be found in a prior Office action.

Claims 9-17 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt (WO 2003/035777), see English language equivalent (Schmidt US 2005/0142292).

7. The text not found in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (WO 2003/035777), see English language equivalent (Schmidt US 2005/0142292), as applied to claim 9 above, and in view of Veya et al (US 2004/0029989).

9. The text not found in this action can be found in a prior Office action.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (WO 2003/035777), see English language equivalent Schmidt US 2005/0142292, in view of Veya et al (US 2004/0029989), as applied to claim 19 above, and further in view of Ghioghiu et al (WO 2001/38445).

11. The text not found in this action can be found in a prior Office action.

Conclusion

12. This is a continued examination (RCE) of Applicant's earlier Application No. 10/599,551. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP

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§ 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/
Primary Examiner,
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